

SN 09/521,614  
Page 13

### **REMARKS**

This response is intended as a full and complete response to the final Office Action mailed October 5, 2005, and is also in response to the Advisory Action mailed on January 30, 2006. This response is also a submission which accompanies an RCE. In the Office Action, the Examiner notes that claims 1-63 are pending and rejected. By this response, claims 1, 22 and 43 have been amended.

In view of the following discussion, Applicant submits that none of the claims now pending in the application are obvious under the provisions of 35 U.S.C. §103. Thus, Applicant believes that all of these claims are now in allowable form.

Applicant does not acquiesce to the Examiner's characterizations of the art of record or to Applicant's subject matter recited in the pending claims. Further, Applicant is not acquiescing to the Examiner's statements as to the applicability of the art of record to the pending claims by filing the instant response.

### **Amendments to the Claims**

By this response, claims 1, 22 and 43 have been amended. The amendments to the claims are fully supported by the Application as originally filed. For example, the amendments to the claims are supported at least by page 74, line 16, to page 75, line 2. Thus, no new matter has been added in the Examiner is respectfully requested to enter the amendments.

### **35 U.S.C. §103 Rejection of Claims 1-5, 8, 9, 12-14, 16, 19-26, 29, 30, 33-35, 37, 40-47, 50, 51, 54-56, 58, 61-63**

The Examiner has rejected claims 1-5, 8, 9, 12-14, 16, 19-26, 29, 30, 33-35, 37, 40-47, 50, 51, 54-56, 58, and 61-63 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 6,553,178-B2 to Abecassis (hereinafter "Abecassis") in view of U.S. Patent 6,510,209 to Cannon (hereinafter "Cannon") and U.S. Patent 6,757,906 to Look (hereinafter "Look"). Applicant respectfully traverses the rejection.

To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art, and there must be motivation to combine the cited references in a manner to obviate the claimed invention.

The Applicant respectfully submits that the Examiner has failed to establish a prima facie case of obviousness of the claimed invention because (i) the Abecassis,

SN 09/521,614  
Page 14

Cannon and Look references, alone or in combination, fail to teach or suggest all of the limitations recited in independent claims 1, 22 and 43, and thus fail to teach or suggest the Applicants' invention as a whole; and (ii) there is no valid motivation to combine the Look reference with the Abecassis and Cannon references.

Specifically, the Abecassis, Cannon and Look references, alone or in combination, fail to teach or suggest at least the "receiving an input from a user, the input identifying at least one predetermined originator of an incoming request for communications;" and the "pausing the outputting of the video program upon detecting the occurrence of the incoming request for communications and determining that an originator of the incoming request for communications comprises any of the at least one predetermined originators;" and the "buffering the video program upon detecting the occurrence of the incoming request for communications and determining that the originator of the incoming request for communications comprises any of the at least one predetermined originators;" as recited in claim 1 as amended, and as substantially similarly recited in claims 22 and 43 as amended.

The Abecassis reference discloses a video on demand system in which the user of the system may accept a communication during use of the system and, in response to the acceptance of such communication, cause a video server transmission to be paused. However, as the Examiner acknowledges, the "combination of Abecassis and Cannon fails to teach buffering the video program when paused" (page 5 of the 10/05/05 Office Action). The Applicants respectfully submit that the Abecassis reference also does not teach or suggest buffering the video program upon the detecting the incoming request for communications and determining the originator comprises a predetermined originator. The Applicants further submit that the Abecassis reference also does not teach or suggest receiving an input from a user identifying the predetermined originator. The Applicants further submit that the Abecassis reference also does not teach or suggest pausing the video program upon determining the originator comprises a predetermined originator.

The Cannon reference fails to bridge the substantial gap between the Abecassis reference and Applicant's invention. The Cannon reference discloses a telephone enabling remote programming of a video recording device. The Cannon reference discloses that a VCR or videodisk player can be paused upon receipt of an incoming

442842\_1.DOC

SN 09/521,614  
Page 15

call. As recited above, the Examiner acknowledges that the "combination of Abecassis and Cannon fails to teach buffering the video program when paused" (page 5 of the 10/05/05 Office Action). The Applicants respectfully submit that the Cannon reference also does not teach or suggest buffering the video program upon the detecting the incoming request for communications and determining the originator comprises a predetermined originator. The Applicants further submit that the Cannon reference also does not teach or suggest receiving an input from a user identifying the predetermined originator. The Applicants further submit that the Cannon reference also does not teach or suggest pausing the video program upon determining the originator comprises a predetermined originator.

The Look reference fails to bridge the substantial gap between the Abecassis and Cannon references and Applicant's invention. Concerning the Look reference, the Examiner alleges (emphasis added below):

"Look discloses a personal video recorder, which buffers an incoming live video program in response to a pause command (column 9, line 38-column 10, line 16, lines 41-50), thus reducing the time it takes to restart a program when it is resumed and providing perfect synchronization (column 10, lines 49-50)." (page 5 of the 10/05/05 Office Action)

Thus, the Examiner alleges that the Look reference discloses buffering a live video program in response to a pause command. However, the Applicants respectfully disagree. The Applicants also respectfully note that the claim language, as amended, now recites "buffering the video program upon detecting the occurrence of the incoming request for communications and determining that the originator of the incoming request for communications comprises any of the at least one predetermined originators."

Regarding a pause feature, the Look reference discloses (emphasis added below):

"The control object 917 accepts commands from the user and sends events into the pipeline to control what the pipeline is doing. For example, if the user has a remote control and is watching TV, the user presses pause and the control object 917 sends an event to the sink 903, that tells it pause. The sink 903 stops asking for new buffers. The current pointer 920 stays where it is at. The sink 903 starts taking buffers out again when it receives another event that tells it to play. The system is in perfect synchronization; it starts from the frame that it stopped at." (column 10, lines 41-50)

442842\_1.DOC

SN 09/521,614  
Page 16

Thus, the Look reference only discloses that, in response to the user pressing pause on a remote control, a 'sink' stops asking for new buffers. The Look reference further discloses that a sink consumes buffers of data, as follows (emphasis added below):

"With respect to FIG. 8, the program logic within the CPU has three conceptual components: sources 801, transforms 802, and sinks 803. The sources 801 produce buffers of data. Transforms 802 process buffers of data and sinks 803 consume buffers of data. A transform is responsible for allocating and queuing the buffers of data on which it will operate. Buffers are allocated as if "empty" to sources of data, which give them back "full". The buffers are then queued and given to sinks as "full", and the sink will return the buffer "empty". (column 8, line 66, to column 9, line 8)

Thus, in response to the user pressing pause on a remote control, a sink is instructed to stop consuming the buffer. This is in contrast to the allegation by the Examiner that the Look reference "buffers an incoming live video program in response to a pause command." As can be seen from the above, there is no teaching in the Look reference regarding buffering live video in response to a pause command. Instead, the Look reference only discloses stopping the consumption of a buffer in response to a pause command.

The Applicant further respectfully notes that even if there is some disclosure of some type buffering in the Look reference, the buffering is done neither upon detecting the occurrence of the incoming request for communications or upon determining that the originator of the incoming request for communications comprises any of the at least one predetermined originators.

Regarding buffering, the Look reference only discloses (emphasis added below):

"The Media Switch 102 mediates between a microprocessor CPU 106, hard disk or storage device 105, and memory 104. Input streams are converted to an MPEG stream and sent to the Media Switch 102. The Media Switch 102 buffers the MPEG stream into memory. It then performs two operations if the user is watching real time TV: the stream is sent to the Output Section 103 and it is written simultaneously to the hard disk or storage device 105." (column 5, lines 16-24)

Thus, the Look reference discloses storing an MPEG stream if the user is watching real time TV. This is very different than the allegation by the Examiner that the Look

SN 09/521,614  
Page 17

reference discloses buffering in response to a pause command, which as discussed above, it does not.

The Applicants respectfully further submit that the Look reference also does not teach or suggest receiving an input from a user identifying the predetermined originator. The Applicants further submit that the Look reference also does not teach or suggest pausing the video program upon determining that the originator comprises a predetermined originator.

Thus, the Abecassis, Cannon and Look references, alone or in any combination, fail to disclose or suggest Applicant's invention as a whole.

Moreover, the Examiner has failed to provide a valid motivation to combine the Look reference with the Abecassis and Cannon references. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. (see MPEP 2143.01(I) and 2143.01(III))

Regarding the motivation to combine the Look reference with the other references, the Examiner alleges (emphasis added below):

"Look discloses a personal video recorder, which buffers an incoming live video program in response to a pause command (column 9, line 38-column 10, line 16, lines 41-50), thus reducing the time it takes to restart a program when it is resumed and providing perfect synchronization (column 10, lines 49-50).

Therefore, it would have been obvious to one skilled in the art at the time of invention to modify the combination of Abecassis and Cannon to buffer the incoming video in response to a pause command for the advantage of thus reducing the time it takes to restart a program when it is resumed and providing perfect synchronization. As Cannon discloses pausing the communication in response to an incoming communications request, and Look discloses buffering a live video stream in response to a pause command, the combination of Abecassis, Cannon, and Look teaches each and every element of claim 1." (page 2 of the 1/30/2006 Advisory Action)

Thus, the Examiner proposes modifying the pausing of the Cannon reference with the alleged teaching of buffering upon a pause command of the Look reference to create the alleged combined teaching of buffering in response to a pause command. Thus, the Examiner is explicitly modifying the disclosure of the Cannon reference with the alleged disclosure of the Look reference. The Examiner further alleges the advantage

442642\_1.DOC

SN 09/521,614  
Page 18

of doing so is reducing the time it takes to restart a program when it is resumed and providing perfect synchronization. However, the Cannon reference only discloses pausing of a VCR or videodisc player, and not of a received live video signal, and thus it would not be desirable by one of ordinary skill in the art to combine this pausing with the alleged teaching of buffering upon pausing because there's no need to buffer a non-live video signal such as that from a VCR or videodisc player. That is, the alleged advantages of reducing the time it takes to restart a program when it is resumed and providing perfect synchronization are not valid for a local signal such as that from a VCR or videodisc player. Therefore, because there would be no additional benefit to one of ordinary skill in the art to buffer a signal from a VCR or videodisc player, it would not be desirable to do so, and therefore there is no valid motivation to combine these alleged disclosures.

Thus, in addition to the Abecassis, Cannon and Look references failing to teach the claimed invention as a whole, the Applicant respectfully submits that the Examiner has failed to provide a valid motivation to combine the Look reference with the Abecassis and Cannon references.

As such, Applicant submits that independent claims 1, 22 and 43 are not obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Furthermore, dependent claims 2-5, 8, 9, 12-14, 16, 19-21, 23-26, 29, 30, 33-35, 37, 40-42, 44-47, 50, 51, 54-56, 58, and 61-63 depend, either directly or indirectly, from independent claims 1, 22, and 43 and recite additional limitations thereof. As such and at least for the same reasons as discussed above, Applicant submits that these dependent claims are also non-obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder.

Therefore, Applicant respectfully requests that the Examiner's rejection be withdrawn.

#### **35 U.S.C. §103 Rejection of Claims 6, 7, 27, 28, 48 and 49**

The Examiner has rejected claims 6, 7, 27, 28, 48 and 49 as being unpatentable over Abecassis in view of Cannon and Look in view of the MSN Messenger Service (hereinafter "MSN"). Applicant respectfully traverses the rejection.

Claims 6, 7, 27, 28, 48 and 49 depend directly or indirectly from independent claims 1, 22 and 43. Moreover, for at least the reasons discussed above, the

442642\_1.DOC

SN 09/521,614  
Page 19

Abecassis, Cannon and Look references fail to teach or suggest Applicants' invention as recited in claims 1, 22 and 43. Accordingly, any attempted combination of the Abecassis, Cannon and Look references with any other additional references, in a rejection against the dependent claims, would still result in a gap in regards to the rejection against the independent claims. As such, Applicants submit that dependent claims 6, 7, 27, 28, 48 and 49 are not obvious and are patentable under 35 U.S.C. §103.

Therefore, Applicants respectfully request that the Examiner's rejection be withdrawn.

**35 U.S.C. §103 Rejection of Claims 10-11, 31, 32, 52 and 53**

The Examiner has rejected claims 10-11, 31, 32, 52 and 53 as being unpatentable over Abecassis in view of Cannon and Look in further view of U.S. Patent 6,349,410 to Lortz (hereinafter "Lortz"). Applicant respectfully traverses the rejection.

Claims 10-11, 31, 32, 52 and 53 depend directly or indirectly from independent claims 1, 22 and 43. Moreover, for at least the reasons discussed above, the Abecassis, Cannon and Look references fail to teach or suggest Applicants' invention as recited in claims 1, 22 and 43. Accordingly, any attempted combination of the Abecassis, Cannon and Look references with any other additional references, in a rejection against the dependent claims, would still result in a gap in regards to the rejection against the independent claims. As such, Applicants submit that dependent claims 10-11, 31, 32, 52 and 53 are not obvious and are patentable under 35 U.S.C. §103.

Therefore, Applicant respectfully requests that the Examiner's rejection be withdrawn.

**35 U.S.C. §103 Rejection of Claims 15, 36 and 57**

The Examiner has rejected claims 15, 36 and 57 as being unpatentable over Abecassis in view of Cannon and Look in further view of U.S. Patent 6,543,053 to Li (hereinafter "Li"). Applicant respectfully traverses the rejection.

Claims 15, 36 and 57 depend directly or indirectly from independent claims 1, 22 and 43. Moreover, for at least the reasons discussed above, the Abecassis, Cannon and Look references fail to teach or suggest Applicants' invention as recited in claims 1,

442642\_1.DOC

SN 09/521,614  
Page 20

22 and 43. Accordingly, any attempted combination of the Abecassis, Cannon and Look references with any other additional references, in a rejection against the dependent claims, would still result in a gap in regards to the rejection against the independent claims. As such, Applicants submit that dependent claims 15, 36 and 57 are not obvious and are patentable under 35 U.S.C. §103.

Therefore, Applicant respectfully requests that the Examiner's rejection be withdrawn.

**35 U.S.C. §103 Rejection of Claims 17, 38 and 59**

The Examiner has rejected claims 17, 38 and 59 as being unpatentable over Abecassis in view of Cannon and Look in further view of U.S. Patent 6,052,508 to Mincy (hereinafter "Mincy"). Applicant respectfully traverses the rejection.

Claims 17, 38 and 59 depend directly or indirectly from independent claims 1, 22 and 43. Moreover, for at least the reasons discussed above, the Abecassis, Cannon and Look references fail to teach or suggest Applicants' invention as recited in claims 1, 22 and 43. Accordingly, any attempted combination of the Abecassis, Cannon and Look references with any other additional references, in a rejection against the dependent claims, would still result in a gap in regards to the rejection against the independent claims. As such, Applicants submit that dependent claims 17, 38 and 59 are not obvious and are patentable under 35 U.S.C. §103.

Therefore, Applicant respectfully requests that the Examiner's rejection be withdrawn.

**35 U.S.C. §103 Rejection of Claims 18, 39 and 60**

The Examiner has rejected claims 18, 39 and 60 as being unpatentable over Abecassis in view of Cannon and Look in further view of the ReplayTV manual (hereinafter "ReplayTV"). Applicant respectfully traverses the rejection.

Claims 18, 39 and 60 depend directly or indirectly from independent claims 1, 22 and 43. Moreover, for at least the reasons discussed above, the Abecassis, Cannon and Look references fail to teach or suggest Applicants' invention as recited in claims 1, 22 and 43. Accordingly, any attempted combination of the Abecassis, Cannon and Look references with any other additional references, in a rejection against the dependent claims, would still result in a gap in regards to the rejection against the



SN 09/521,614  
Page 21

independent claims. As such, Applicants submit that dependent claims 18, 39 and 60 are not obvious and are patentable under 35 U.S.C. §103.

Therefore, Applicant respectfully requests that the Examiner's rejection be withdrawn.

### CONCLUSION

Thus, Applicant submits that none of the claims presently in the application are obvious under the provisions of 35 U.S.C. §103. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, it is requested that the Examiner telephone Stephen Guzzi, at (732) 383-1405, or Eamon J. Wall, at (732) 530-9404, so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

Dated: 2/28/06



Eamon J. Wall  
Registration No. 39,414  
Attorney for Applicants

PATTERSON & SHERIDAN, LLP  
595 Shrewsbury Avenue, Suite 100  
Shrewsbury, New Jersey 07702  
Telephone: 732-530-9404  
Facsimile: 732-530-9808